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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/826,664
Filing Date: April 05, 2001
Appellant(s): SCHROEDER, PAUL B.

Francis Lammes
Reg. No. 55,353
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 27 June 2006 appealing from the Office action mailed 19 April 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6096096	Murphy et al.	8-2000
6243071	Shwarts et al.	6-2001
5917491	Bauersfeld	6-1999
5642503	Reiter	6-1997
6037934	Himmel et al.	3-2000
6330007	Isreal et al.	12-2001
6321228	Crandall et al.	11-2001
6427175	Khan et al.	6-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 9-10, 30, 36-37, and 47-48 remain rejected under 35 U.S.C. 102(e) as being anticipated by Khan et al. (US 6460038, filed 24 September 1999, hereafter Khan) and further in view of Murphy et al. (US 6096096, filed 13 December 1996, hereafter Murphy) and further in view of Shwarts et al. (US 6243071, filed 3 November 1993, hereafter Schwartz).

Regarding independent claim 1, Khan discloses a method in a data processing system for creating bookmarks (in col. 18, lines 15-65, the invention creates bookmarks), comprising: receiving a request to create a new bookmark for a document (in order to create a bookmark it is inherently necessary that a creation request is received); creating a bookmark link (since the reference bookmark is accessed remotely, it is necessary to create a link to it); and linking the bookmark link to the reference bookmark (linking the bookmark link is a necessary part of creating the bookmark link).

Khan fails to specifically disclose wherein the link is a symbolic link. However, Murphy discloses the use of symbolic links (column 9, lines 10-55). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Khan and Murphy, since it would have facilitated access to data on other file systems.

Khan further fail to disclose determining whether a reference bookmark already exists for the document. However, Shwarts discloses determining whether a reference bookmark already exists for the document (Figure 15, item 320; column 18, line 60-column 19, line 19). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Khan and Shwarts, since it would have allowed a user to avoid creating several static bookmarks to the same resource (Shwarts: column 18, lines 60-65).

Regarding independent claim 9, it is essentially the same as claim 1 except that there is no determining step, and since it is broader, it is rejected under the same rationale.

Regarding dependent claim 10, identifying a reference bookmark inherently involves presenting at least one existing bookmark; receiving a selection of a reference bookmark from the at least one existing bookmark because there is no logical way to accomplish this task other than assembling a group of candidates and choosing one.

Regarding independent claim 30, it is an apparatus that performs the method of claim 1 and it is rejected under the same rationale.

Regarding independent claim 36, it is an apparatus that performs the method of claim 9 and it is rejected under the same rationale.

Regarding dependent claim 37, it is an apparatus that performs the method of claim 10 and it is rejected under the same rationale.

Regarding independent claim 47, it is a computer program in a computer-readable medium that encodes the method of claim 1 and is rejected under similar rationale.

Regarding independent claim 48, it is a computer program in a computer-readable medium that encodes the method of claim 9 and is rejected under similar rationale.

Claims 2-3, 5, 15-16, and 32 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, and Shwartz, and further in view of Bauersfeld (USPN 5,917,491—filing date 8/29/1997).

Regarding dependent claim 2, Khan Murphy, and Shwartz fail to disclose receiving a name for the bookmark link. However, Bauersfeld, in col. 3, lines 20-30,

discloses that links have name to aid in identifying them. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Bauersfeld's practice of naming links into Khan in order aid in identifying links.

Regarding dependent claim 3, Khan Murphy, and Shwartz fail to disclose receiving a description for the bookmark link. However, Bauersfeld, in col. 3, lines 20-30, discloses that links have descriptions to aid in storing background information about them. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Bauersfeld's practice of naming links into Khan in order aid in storing background information about them.

Regarding dependent claim 5, Khan Murphy, and Shwartz fail to disclose that each bookmark includes a uniform resource locator for the document. However, Bauersfeld, in col. 3, lines 10-20 discloses that bookmarks have URLs in order to aid in retrieving the web page associated with the bookmark subsequently. It would have been obvious to one of ordinary skill in the art at the time of the invention to use URLs with the bookmarks in Khan after the manner of Bauersfel in order to aid in retrieving the web page associated with the bookmark subsequently.

Regarding dependent claim 15, it contains the same limitation as claim 5 and is rejected under the same rationale.

Regarding dependent claim 16, it incorporates the determination step from claim 1 into claim 15 and it is rejected under the same rationale.

Regarding independent claim 32, it is an apparatus that performs the method of claim 5 and it is rejected under the same rationale.

Claims 4, 20, and 31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, and Shwarts, further in view of Reiter (USPN 5,642,503—filing date 12/15/1993).

Regarding dependent claim 4, Khan, Murphy, and Shwarts fails to disclose that the step of linking the bookmark link to the reference bookmark comprises storing a pointer to the reference bookmark in the bookmark link. However, Reiter in col. 3, lines 65-67 and col. 4, lines 1-20 discloses how linking involves storing a pointer (see col. 4 lines 13-15) in order to efficiently and elegantly record relevant linking information. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Khan by linking with a pointer as in Reiter in order to efficiently and elegantly record relevant linking information.

Regarding dependent claim 20, it incorporates the limitations of claim 4 into claim 9 and is rejected under the same rationale.

Regarding dependent claim 31, it is an apparatus that performs the method of claim 4 and it is rejected under the same rationale.

Claims 6, 17, and 33 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, Shwarts, and Bauersfeld, further in view of Himmel et al. (USPN 6,037,934—filing date 11/21/1997), hereinafter Himmel.

Regarding dependent claim 6, Khan, Murphy, and Shwarts and Bauersfeld fail to disclose that the step of determining whether a reference bookmark already exists for

the document comprises comparing the uniform resource locator of the bookmark to the uniform resource locator of each existing bookmark. However, Himmel discloses in col. 17, lines 55-65 that URLs are compared to determine if bookmarks exist, in order to detect redirection conditions. It would have been obvious to one of ordinary skill in the art at the time of the invention to compare URLs as in Himmel in the context of Khan in order to detect redirection conditions.

Regarding dependent claim 17, it incorporates the limitations of claim 6 into claim 16 and is rejected under the same rationale.

Regarding independent claim 33, it is an apparatus that performs the method of claim 6 and it is rejected under the same rationale.

Claims 7-8 and 34-35 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, and Shwartz, further in view of Isreal et al. (USPN 6,330,007 B1—filing date 12/18/1998), hereinafter Isreal.

Regarding dependent claim 7, Khan, Murphy, and Shwartz fails to disclose that if a reference bookmark already exists, prompting a user whether to create the bookmark link. However, Isreal discloses in col 12, lines 30-45 prompting the user if duplication of a screen ID is found. This is analogous art because in both cases duplication occurs and prompting is the response. It would have been obvious to one of ordinary skill in the art at the time of the invention to add Isreal's feature of prompting upon duplication to Khan because it gives the user a chance to select an appropriate response to the case when duplication occurs.

Regarding dependent claim 8, Khan, Murphy, and Shwartz and Isreal fail to disclose that the step of creating the bookmark link comprising creating the bookmark link in response to a user's request to create the bookmark link. However, it was notoriously well known in the art at the time of the invention that when a user is prompted for an action, it is obvious to carry out the action if the user decides to do the action. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention to actually create the link if the user selected this course action at the prompt because this would satisfy the user's expectations.

Regarding dependent claim 34, it is an apparatus that performs the method of claim 7 and it is rejected under the same rationale.

Regarding dependent claim 35, it is an apparatus that performs the method of claim 8 and it is rejected under the same rationale.

Claims 11-14 and 38-40 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, and Shwartz, further in view of Crandall et al. (USPN 6,321,228 B1—filing date 8/31/1999), hereinafter Crandall.

Regarding dependent claim 11, Khan Murphy, and Shwartz fail to disclose the step of presenting at least one existing bookmark comprises presenting the at least one existing bookmark in a tree structure. However, Crandall discloses in col. 4, lines 1-10 that bookmarks have a tree structure. It would have been obvious to one of ordinary skill in the art at the time of the invention to present the bookmarks in a tree structure in

the manner of Crandall in order to efficiently store the bookmark information in a hierarchy.

Regarding dependent claim 12, Khan, Murphy, and Shwarts and Crandall fail to explicitly disclose that the step of receiving a selection of a reference bookmark comprises receiving the selection of the reference bookmark in the tree structure. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have this be the case based on claim 11, wherein the bookmarks are presented in a tree structure, and hence it would be obvious to receive the reference bookmark via the tree structure because this would match the user's clear expectations.

Regarding dependent claim 13, Khan, Murphy, and Shwarts fail to disclose displaying a symbolic representation of the bookmark link in the tree structure. However, Crandall discloses displaying a symbolic representation of the bookmark link in the tree structure in col. 6, lines 30-45. It would have been obvious to one of ordinary skill in the art at the time of the invention to display a symbolic representation of the bookmark link in the tree structure as in Crandall in the context of Khan '038 in order to provide the user with a tool for visualizing the bookmark structure.

Regarding dependent claim 14, Khan, Murphy, and Shwarts and Crandall fail to disclose that modifications to the reference bookmark are displayed in relation to the symbolic representation of the bookmark link in the tree structure. However, it was notoriously well known in the art at the time of the invention that users expect displayed material to be an accurate representation of the underlying data structure. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention to

have modifications to the reference bookmark be displayed in relation to the symbolic representation of the bookmark link in the tree structure in order to have the displayed material be an accurate representation of the underlying data structure.

Regarding dependent claim 38, it is an apparatus that performs the method of claim 11 and it is rejected under the same rationale.

Regarding dependent claim 39, it is an apparatus that performs the method of claim 12 and it is rejected under the same rationale.

Regarding dependent claim 40, it is an apparatus that performs the method of claim 13 and it is rejected under the same rationale.

Claims 18-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, and Shwartz, further in view of Isreal, further in view of Bauersfeld.

Regarding dependent claim 18, it incorporates the limitations of claim 7 into claim 16 and is rejected under the same rationale.

Regarding dependent claim 19, it incorporates the limitations of claim 8 into claim 16 and is rejected under the same rationale.

Claims 21-22, 41-42, and 49 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, and Shwartz further in view of Khan et al. (USPN 6,427,175 B1—filing date 9/24/1999), hereinafter Khan '175.

Regarding independent claim 21, the claim is analogous to claim 1 except that instead of bookmarks, bookmark folders are manipulated. However, Khan '175

discloses the use of bookmark folders as organizational tools for bookmarks in lines 1-20 of the Abstract. It would have been obvious to one of ordinary skill in the art at the time of the invention to use bookmark folders in the context of Khan in the manner of Khan '175 in order to take advantage of bookmark folders' applicant as organizational tools for bookmarks.

Regarding dependent claim 22, it modifies claim 21 in a way analogous to the way in which claim 10 modifies claim 9, and is rejected under similar rationale.

Regarding independent claim 41, it is an apparatus that performs the method of claim 21 and it is rejected under the same rationale.

Regarding dependent claim 42, it is an apparatus that performs the method of claim 22 and it is rejected under the same rationale.

Regarding independent claim 49, it is a computer program in a computer-readable medium that encodes the method of claim 21 and is rejected under similar rationale.

Claims 23-26 and 43-46 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, Shwartz, and Khan '175, further in view of Crandall.

Regarding dependent claim 23, it modifies claim 22 in a way analogous to the way in which claim 11 modifies claim 10, and is rejected under similar rationale.

Regarding dependent claim 24, it modifies claim 23 in a way analogous to the way in which claim 12 modifies claim 11, and is rejected under similar rationale.

Regarding dependent claim 25, it modifies claim 23 in a way analogous to the way in which claim 13 modifies claim 11, and is rejected under similar rationale.

Regarding dependent claim 26, it modifies claim 25 in a way analogous to the way in which claim 14 modifies claim 13, and is rejected under similar rationale.

Regarding dependent claim 43, it is an apparatus that performs the method of claim 23 and it is rejected under the same rationale.

Regarding dependent claim 44, it is an apparatus that performs the method of claim 24 and it is rejected under the same rationale.

Regarding dependent claim 45, it is an apparatus that performs the method of claim 25 and it is rejected under the same rationale.

Regarding dependent claim 46, it is an apparatus that performs the method of claim 26 and it is rejected under the same rationale.

Claim 27 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, Shwarts, and Khan '175, and further in view of Bauersfeld (USPN 5,917,491—filing date 8/29/1997).

Regarding dependent claim 27, it modifies claim 21 in a way analogous to the way in which claim 2 modifies claim 1, and is rejected under similar rationale.

Claims 28 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Khan Murphy, Shwarts, and Khan '175, and further in view of Bauersfeld.

Regarding dependent claim 28, it modifies claim 21 in a way analogous to the way in which claim 3 modifies claim 1, and is rejected under similar rationale.

Claims 29 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Khan Murphy, Shwarts, and Khan '175, and further in view of Reiter (USPN 5,642,503—filing date 12/15/1993).

Regarding dependent claim 29, it modifies claim 21 in a way analogous to the way in which claim 4 modifies claim 1, and is rejected under similar rationale.

(10) Response to Argument

With respect to claims 1, 9, 10, 30, 36-37, and 47-48, the appellant argues that Khan, Murphy, and Shwarts, “taken alone or in combination, do not teach or suggest, in response to receiving a request to create a new bookmark, determine whether a reference bookmark already exists for the document (page 18).” However, the examiner respectfully disagrees. However, Shwarts states, “a decision step 320 determines whether a bookmark already exists for the current page (column 18, lines 63-65). This decision step is activated in response to the selection of a “mark this page” button (column 18, lines 60-63).

The appellant further states that Shwarts “rejects creating a bookmark upon the determination that the bookmark page already exists (page 19). The examiner agrees with this assessment. Like the appellant’s claim limitations, Shwarts makes a

determination whether a bookmark already exists, and then performs an action based upon this determination (column 18, line 60- column 19, line 19).

The appellant further states that Shwarts' teachings are completely opposite of Khan's (page 20). The examiner acknowledges that Khan fails to determine whether a bookmark already exists before creating a bookmark, often leading to multiple bookmarks to the same information. Shwarts first determines whether a bookmark exists, if it does, a second bookmark is not created, thereby maintaining only a single bookmark to information. Further, the appellant claims that in response to determining that a bookmark already exists, "a new bookmark is not created (claim 1, lines 7-8). As previously stated, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Khan and Shwarts, since it would have allowed a user to avoid creating several static bookmarks to the same resource (Shwarts: column 18, lines 60-65).

The appellant further argues that Khan and Shwarts do not teach or suggest creation of a symbolic link (page 20). The examiner readily acknowledges this, and the Murphy reference has been added to address this limitation. Murphy discloses the use of symbolic links (column 9, lines 10-55). Murphy discloses the use of symlinks to abstract over the location of data within the file structure (column 7, lines 48-65). This enables the linking of files and directories residing on other file systems (column 9, lines 25-28; column 9, line 55- column 10, line 12). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Khan and Murphy, since it would have facilitated access to data on other file systems (column

9, lines 25-28; column 9, line 55- column 10, line 12). Further, symbolic links are well known in the art to be a special file type, which is a small pointer file, allowing multiple names for the same file. Unlike hard links, symbolic links can be made for directories and can be made across file systems. Commands that access the file being pointed to are said to follow the symbolic link. Commands that access the link itself do not follow the symbolic link. This allows a user to have multiple names for a link pointing to the same file or document. Although Murphy does not specifically disclose using symbolic links in conjunction with bookmarks, Khan discloses bookmarks incorporating links (column 18, lines 15-65). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Khan and Murphy, since it would have facilitated access to data on other file systems. Further, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Khan and Murphy, since it would have allowed a user to maintain several names for a link pointing to the same resource.

The appellant further argues that Murphy is not analogous art (page 23). It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Murphy is concerned with linking data, similar to the appellant's linking of an existing bookmark and a symbolic link.

With respect to claims 2-3, 5, 15-16, and 32, the appellant presents the arguments substantially similar to those presented with respect to claim 1 (page 25).

With respect to claims 4, 20, and 31, the appellant argues that the combination of Khan, Murphy, Shwartz, and Reiter fail to teach or suggest linking the symbolic link to the already existing reference by storing a pointer to the already existing reference bookmark in the symbolic link (page 26). The examiner respectfully disagrees. Reiter discloses the use of an entry comprising an address field and both forward and backward links (column 3, line 65- column 4, line 20). These forward and backward links are pointers to other entries (column 3, lines 65- column 4, line 20). Although Khan, Murphy, and Shwartz disclose storing bookmarks without disclosing storing pointers to other entries, the addition of Reiter teaches the limitation.

With respect to claims 6, 17, and 33, the appellant presents the arguments substantially similar to those presented with respect to claim 1 (page 27).

With respect to claims 7-8 and 34-35, the appellant argues that Isreal fails to teach creation in response to a user's request (page 28). The examiner respectfully disagrees. Isreal discloses opening a prompt box asking a user whether he/she would like to create a screen (column 12, lines 30-45). If the user responds in the affirmative, the screen is created (column 12, lines 30-45). Applying the prompt to creation of a bookmark as taught by Khan, Murphy, and Shwartz would result in the limitations similar to those claims 7-8 and 34-35.

With respect to claims 11-14 and 38-40, the appellant presents the arguments substantially similar to those presented with respect to claim 1 (page 29). Therefore, these claims stand rejected based at least on the arguments above.

With respect to claims 18-19, the appellant presents the arguments substantially similar to those presented with respect to claim 1 (page 30). Therefore, these claims stand rejected based at least on the arguments above.

With respect to claims 21-22, 41-42, and 49, the appellant presents the arguments substantially similar to those presented with respect to claim 1 (page 30). Therefore, these claims stand rejected based at least on the arguments above.

With respect to claims 23-26, and 43-46, the appellant presents the arguments substantially similar to those presented with respect to claims 10-14 (page 32). Therefore, these claims stand rejected based at least on the arguments above.

With respect to claims 27-28, the appellant presents the arguments substantially similar to those presented with respect to claims 1-3 (page 33). Therefore, these claims stand rejected based at least on the arguments above.

With respect to claim 29, the appellant presents the arguments substantially similar to those presented with respect to claim 4 (page 34). Therefore, these claims stand rejected based at least on the arguments above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 2178

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



krs



CESAR PAULA
PRIMARY EXAMINER

Conferees:



Stephen Hong, SPE 2178



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